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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,882	01/03/2001	Mark E. Peters	RSW920000111US1	1389

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,882

Applicant(s)

PETERS, MARK E.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 8/6/04 to the application filed 1/03/01.
2. Claims 1-32 are pending in the case. Claims 1, 11, 13, 23 are independent claims.
3. The objections of claims 5 and 14 due to informalities have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al. (US Pat No. 5,740,549, 4/14/98, filed 6/12/95) in view of Eldering (US Pat No. 6,324,519 B1, 11/27/01, filed 3/12/99).

Regarding independent claim 1, Reilly discloses:

- generating a subscriber list including identifications of a plurality of subscribers for the publication (**col 4, lines 2-7**: the fact that the list of subscribers is provided to the server indicates that generating such a list should be performed for providing to the server; **col 16, lines 46-54**: the fact that the server's database

includes a catalog which lists all subscribers authorized to receive new items and advertisements from the server indicates that generating a list of subscriber should be performed; also, it was obvious that the subscriber list should have the names of the subscribers, which are the identifications of the subscribers)

- providing, to a content provider, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber (**col 4, lines 2-7**: a *set of subscribers* is provided to a LAN server; **col 16, lines 46-54**: subscribers in the list authorized to receive new items and advertisements are provided to the server; it was obvious that the subscribers in the list are at least the first and the second subscribers and must have the subscribers' names, which are the identifications of the subscribers)
- receiving a designation of a first selected content and a second selected content from the content provider (**col 15, lines 28-52**: the fact that the news items corresponding to the subscriber's user profile *are selected* shows a designation of selected contents for corresponding subscribers)
- associating the first selected content with the first subscriber based on the identification of the first subscriber (**col 15, lines 28-52**: the fact that only news items corresponding to the subscriber's user profile are selected to be provided to users shows associating a selected content with a subscriber; though Reilly does not disclose that said associating is applied to the first or second content, the first or second subscriber, the fact that associating a selected content with a

subscriber where each subscriber has a name or an identifier (figure 4) suggests said associating be applied to the first or second subscriber with the first or second content depending on the subscriber's identification in each subscriber's profile)

- associating the second selected content, different from the first subscriber based on the identification of the second subscriber (see step associating above)

Reilly does not explicitly disclose:

- generating a first version of the publication including the first selected content for the first subscriber
- generating a second version of the publication including the second selected content for the second subscriber

Eldering discloses:

- generating a version of publication including the selected content for a subscriber
(col 3, line 65 to col 4, lines 1-16: the advertisements based on a consumer profile that are inserted into a newspaper and delivered to a consumer are considered as a specific version of publication generated for a subscriber)

Though Eldering does not disclose explicitly the first version and the second version, the first selected content and the second selected content, the first subscriber and the second subscriber, the fact that Eldering discloses a specific version of publication for a subscriber suggests that each different version of publication be generated for each subscriber identified by the subscriber's name or identifier. In other words, the first

version of publication is generated for the first subscriber, and the second version of publication is generated for the second subscriber.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering discloses generating a version of publication including the selected content, which is an advertisement for delivering to a subscriber thus motivating to incorporate the advertisement provided to a subscriber based on the subscriber's profile to any newspaper or magazine delivered to a subscriber. As such, subscribers or consumers would receive more targeted advertisements that match their lifestyle and interests via the magazine and newspaper, and the selling companies would sell more products thanks to the advertisement's method.

Regarding claim 2, which is dependent on claim 1, Reilly discloses the content provider is an advertiser and the first selected content and the second selected content are advertisements (col 2, lines 42-47, 62-67).

Regarding claim 3, which is dependent on claim 1, Reilly discloses that the step of receiving a designation of a first selected content and a second selected content from the content provider further comprises the step of receiving a designation of a first selected content based on preferences of the first subscriber and a second selected content based on preferences of the second subscriber from the content provider (**col 3, lines 15-23; col 15, lines 28-40**: the advertisements provided to subscribers based on

subscriber's profile shows that the content is selected for being suitable to the subscriber's interest via the subscriber's preferences). Reilly does not disclose explicitly that the preferences are the buying preferences.

Eldering discloses that providing the advertisements to a subscriber is based on the subscriber's *product preferences* determined by the *purchase records* of the subscriber (col 4, lines 11-54, col 8, lines 15-33, col 10, lines 16-28: the specific purchase records and the product preference characteristics show the buying preferences of the subscriber).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering discloses providing advertisements to a subscriber based on the buying preferences thus motivating to incorporate to Reilly the buying preferences as a specific type of preferences for determining the subscriber's interest to provide the advertisement of interest to a subscriber. Further, since the method can be applied for providing a suitable advertisement to a subscriber identified by name or identifier, it is suggested that the method can be applied to the first or the second subscriber with the first or second advertisement respectively.

Regarding claim 4, which is dependent on claim 2, Reilly discloses generating a first version of the publication including the first selected content in a prescribed field of the publication for the first subscriber, and generating a second version of the publication including the second selected content in a prescribed field of the publication for the

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second subscriber (figure 5: the Sports News Profile includes prescribed fields for a subscriber to check boxes of interest where the topics of the checked boxes are used as the subscriber's preferences for determining a suitable content or a suitable advertisement to be provided to a subscriber; therefore, a version of the publication including the selected content, which is the selected advertisement, is generated based on generating of the selected content; also, as mentioned before, since the method can be applied to a subscriber and a correspondent selected content, it was obvious that the method can be applied for a first subscriber or a second subscriber with the first selected content or the second selected content).

Regarding claim 5, which is dependent on claim 1, Reilly does not disclose:

- integrating content not designated by the content provider into the first version of the publication and the second version of the publication
- printing the first version and the second version of the publication
- distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber

Eldering discloses:

- integrating content not designated by the content provider into the first version of the publication and the second version of the publication (col 11, line 63 to col 12, line 8: integrating the magazines or newspapers, which are content not designated by the content provider with the advertisement into the publication)

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- printing the first version and the second version of the publication (col 11, line 63 to col 12, line 8: printing the advertisement and the magazine or the newspaper as a version of publication)
- distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber (col 11, lines 63 to col 12, line 8: *delivering the printed ad inserted into the periodical to the subscriber*)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering teaches integrating the advertisement into the periodical as a version of publication and distributing the printed version of advertisement and periodical to a subscriber thus motivating to incorporate into Reilly for conveniently distributing the selected advertisement to the subscriber along with the periodical.

Regarding claim 6, which is dependent on claim 1, Reilly discloses:

- receiving the at least a portion of the subscriber list (col 4, lines 2-15: *a set of subscribers* located within a LAN and are connected to a LAN server suggests that at least a portion of the subscriber list be received since only a set of subscribers is provided and received at the LAN server)
- obtaining a first designation of content as the designation of the first selected content based on the identification of the first subscriber (**col 15, lines 28-52**: the fact that the news items corresponding to the subscriber's profile *are selected*

shows a designation of selected contents for corresponding subscribers; though Reilly does not explicitly disclose the first or second designation of content, the first or second content, and the first or second subscriber, the fact that said obtaining is applied for a subscriber based on the subscriber's profile where each subscriber's profile has a subscriber identifier for identifying each subscriber (figure 4) suggests that said obtaining can be applied to the first subscriber or the second subscriber with the first or second content respectively)

- obtaining a second designation of content as the designation of the second selected content based on the identification of the second subscriber (see step obtaining above)
- transmitting the designation of content as the designation of the selected content (figure 5: when a subscriber selects one or more topics or select all topics for creating a subscriber profile, the system transmits the designation of the selected topics for determining a corresponding advertisement; **col 15, lines 28-52**: the fact that the *news items corresponding to the subscriber's profile are selected to be provided to the subscribers* shows a designation of selected contents for corresponding subscribers)

Reilly does not disclose:

- determining if any individually targeted content from the content provider is to be provided in the publication for the first subscriber
- determining if any individually targeted content from the content provider is to be provided in the publication for the second subscriber

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Eldering discloses:

- determining if any individually targeted content from the content provider is to be provided in the publication for the first subscriber (**col 3, lines 11-67**: the fact that the content provider can insert the advertisement into the subscriber device suggests that the system determine a targeted content from the content provider in the publication for a subscriber; **col 10, lines 16-28**: the fact that the advertisement is provided to a consumer (or subscriber) based on the correlation of the consumer profile by the content provider suggests a determination of an individually targeted content to be provided to a subscriber; Eldering does not specifically point out that said determining for the first subscriber or the second subscriber, however Eldering does suggest said determining for a subscriber, therefore, said determining is applied for either the first subscriber or the second subscriber)
- determining if any individually targeted content from the content provider is to be provided in the publication for the second subscriber (see said determining above)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly for obtaining a first designation of content as the designation of the first selected content based on the identification of the first subscriber (disclosed by Reilly) if any individually targeted content is to be provided in the publication for the first subscriber (said determining disclosed by Eldering), and obtaining a second designation of content as the designation of the second selected

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content based on the identification of the second subscriber (disclosed by Reilly) if any individually targeted content is to be provided in the publication for the subscriber (said determining disclosed by Eldering). The combination of Eldering and Reilly would provide the ability of using the subscriber's identifier as a factor along with the subscriber's profile for selecting a content suitable to a subscriber and properly mapping the selected content to a subscriber.

Regarding claim 7, which is dependent on claim 6, Reilly discloses that the first designation of content comprises the first selected content (**col 15, lines 28-40**: the fact that only new items corresponding to the subscriber's profile are provided to the subscriber shows a designation of content for a subscriber; accordingly, the first designation of content is for a first subscriber, the second designation of content is for the second subscriber, etc..).

Regarding claim 8, which is dependent on claim 6, Reilly does not disclose that the first designation of content comprises a first identifier of information maintained by a printer of the publication and wherein the step of transmitting the first designation of content further comprises the step of transmitting the first identifier to the printer of the publication.

Eldering discloses printing the advertisement, inserting it into the periodicals, and delivering it to the subscriber (col 12, lines 1-8).

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Eldering for obtaining a designation of content comprising an identifier of information maintained by a printer of the publication and transmitting the identifier to the printer of the publication for the following reason.

The fact that Eldering discloses printing the advertisement and delivering it to the subscriber suggests that *the content designated to be printed* have an identifier of information when transmitted to a printer and maintained by a printer for handling the printing process.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering suggests an identifier of information transmitted to a printer thus motivating to incorporate into Reilly for printing the selected advertisement for a subscriber, offering another way to provide an advertisement to a subscriber in addition to transmitting the selected advertisement to a subscriber electronically.

Regarding claim 9, which is dependent on claim 6, Reilly discloses determining if any individually targeted content is to be provided based on individual profile information maintained by the content provider for each of the first and second subscribers (col 15, lines 28-40: the fact that the news items are filtered to be provided to the subscriber corresponding to the subscriber's profile suggests said determining for each of the first and second subscriber since each subscriber profile has an identifier for each subscriber with a different user preference).

Eldering also discloses determining if any individually targeted content is to be provided based on individual profile information maintained by the content provider for each of the first and second subscribers (col 3, lines 11-67: the fact that the content provider can insert the advertisement into the subscriber device suggests that the system determine a targeted content from the content provider for a subscriber; col 10, lines 16-28: the fact that the advertisement is provided to a consumer (or subscriber) based on the correlation of *the consumer profile* by the content provider suggests a determination of an individually targeted content to be provided to a subscriber; Eldering does not specifically point out that said determining for the first subscriber or the second subscriber, however Eldering does suggest said determining for a subscriber, therefore, said determining is applied for either the first subscriber or the second subscriber).

Regarding claim 10, which is dependent on claim 9, Reilly does not disclose:

- identifying a first target advertiser for the first subscriber based on the individual profile information for the first subscriber
- identifying a second target advertiser for the second subscriber based on the individual profile information for the second subscriber
- wherein the step of obtaining a first designation of content further comprises the step of obtaining a designation of content associated with the identified first target advertiser

- wherein the step of obtaining a second designation of content further comprises the step of obtaining a designation of content associated with the identified second target advertiser

Eldering discloses:

- identifying a first target advertiser for the first subscriber based on the individual profile information for the first subscriber (col 1, line 45 to col 2, lines 1-21: matching the advertiser whose ads will be received by the appropriate audience based on the product preference included in the consumer characterization suggests that the target advertiser along with the target advertisement be identified for a subscriber; as mentioned above, since said identifying is applied to a target advertiser for a subscriber based on the information of *the subscriber*, it is suggested that said identifying can be applied to a first subscriber or a second subscriber)
- identifying a second target advertiser for the second subscriber based on the individual profile information for the second subscriber (see step identifying above)
- wherein the step of obtaining a first designation of content further comprises the step of obtaining a designation of content associated with the identified first target advertiser (col 1, line 45 to col 2, lines 1-21: the fact that the selected ads provided by the advertisers will be received by the appropriate audience suggests that the designation of selected advertisement is associated with the advertiser; also, since each advertiser has a different type of advertisement, a

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designation of an advertisement should be associated with an advertiser, and thus there are an association between a first designation of a first advertisement and a first advertiser, and an association between a second designation of a second advertisement is associated with a second advertiser)

- wherein the step of obtaining a second designation of content further comprises the step of obtaining a designation of content associated with the identified second target advertiser (see step obtaining above)

Claims 11-12 are for a system of method claims 1, 3, 5-7, and are rejected under the same rationale.

Claims 13-22 are for a system of method claims 1-10, and are rejected under the same rationale.

Claims 23-32 are for a computer program product of method claims 1-10, and are rejected under the same rationale.

Response to Arguments

6. Applicant's arguments filed 8/6/04 have been fully considered but they are not persuasive.

Applicants argue that Reilly does not disclose providing, to a content provider, at least a portion of the subscriber list as recited in claim 1 since Reilly does not discuss a "content provider" at all (Remarks, pages 14-15).

Examiner respectfully disagrees.

As admitted by Applicants, Reilly describes interaction between two entities, an information server and a client computer, where the client initiates a connection with the server and sends its user profile, and the server selects and sends content to the client (Remarks, page 15).

Since Reilly has an information server *whose function is providing data or information to users*, the information server is considered equivalent to a content provider.

Applicants further argue that Reilly discloses only two entities, an information server and a client computer whereas the invention discloses three entities, a content provider, a subscriber, and third entity that performs the "providing, "receiving, "and "associating" operations between the content provider and the subscriber (Remarks, page 15).

Examiner respectfully disagrees.

The two entities or the three entities is not relevant, provided the claimed operations "providing", "receiving", and "associating" can be performed by Reilly.

Applicants argue that Eldering does not disclose different versions of a publication for different subscribers but teaching one version of a publication is delivered to multiple subscribers (Remarks, pages 15-16).

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Examiner respectfully disagrees.

Eldering discloses that the advertisements for each consumer are based on a consumer profile and are inserted into a newspaper and delivered to a consumer (col 3, line 65 to col 4, lines 1-16). Since each consumer, equivalent to a subscriber, has a specific profile, there must be different versions of advertisements for different subscribers.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Buckley et al. (US Pat No. 6,798,530 B1, 9/28/04, filed 12/7/99).

Kramer et al. (US Pat No. 6,327,574 B1, 12/4/01, filed 2/1/99).

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Petersen et al. (US Pat No. 6,308,179 B1, 10/23/01, filed 8/31/98).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh
3/17/05


STEPHEN HONG
SUPERVISORY PATENT EXAMINER